

No. 39.

IN THE

UNITED STATES CIRCUIT COURT OF APPEALS,
FOR THE NINTH CIRCUIT.

HUNT BROTHERS' FRUIT PACKING COMPANY,
Plaintiff in Error,

vs.

JOHN W. CASSIDY,
Defendant in Error.

Brief of Plaintiff in Error.

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BRIEF OF THE PLAINTIFF IN ERROR.

This cause is brought to this Court by a writ of error, from the Circuit Court for the Northern District of California. The action was brought by the defendant in error to recover damages for an alleged infringement of U. S. Letters Patent No. 172,608, bearing date January 25, 1876, and granted to said defendant in error, John W. Cassidy, for alleged improvements in a drying apparatus. The pleadings are in the usual form. Notice of special matter was duly given by the plaintiff in error.

The action was tried by jury. A verdict was rendered for the plaintiff in the case, John W. Cassidy, for the sum of thirteen hundred and fifty dollars, and judgment was entered thereon in the said Cassidy's favor.

In this brief we will call the said Cassidy "plaintiff" and the Hunt Brothers Fruit Packing Company "defendant," as they were in the Court below.

On the trial four witnesses were called by the plaintiff and testified in the case. There was also introduced in evidence the patent sued on and also models of fruit dryers.

The plaintiff then rested his case and the defendant asked the Court to instruct the jury to bring in a verdict for the defendant. The Court overruled the motion and the defendant excepted. Eight other exceptions were taken during the trial by the defendant. Some of them were on account of the admission of testimony that the defendant objected to; and some were taken on account of the refusal of the Court to allow certain questions to be asked witnesses.

Our assignment of errors is in the Record, from page 122 to page 132.

Each assignment of error is based upon an exception that was taken during the trial, and which is contained in the bill of exceptions. The assignment of errors therefore may be referred to as showing the exceptions in the case. This will be most convenient,

as many of the exceptions often refer to one subject and they can be grouped under a few heads, and each group discussed under the single heading to which it belongs; and the argument thereby shortened.

The exceptions shown under assignment of errors, from ten to thirty-four, inclusive, were all taken on account of the refusal of the Court to give instructions asked for by the defendant.

The exceptions taken, which are shown under assignment of errors, from number thirty-five to number forty-one, both inclusive, are all based upon instructions which were given to the jury against the objections of the defendant. Only forty-one exceptions were taken.

ARGUMENT.

The first exception was taken to the ruling of the Court in permitting the plaintiff to give his opinion as to the relative cost between his patented fruit dryer and the old Alden fruit dryer. The witness had already stated that he did not know what the Alden dryer cost and he could only give an opinion.

If the cost of the Alden dryer was admissable at all it was a fact that was capable of positive proof, and it was not proper to allow a mere opinion to be given by a mechanic who had never built one of them.

The next exception is one of much more importance. At the close of the plaintiff's opening testimony and after he had rested his case, the defendant asked for an instruction that the jury should bring in a verdict for the defendant, which motion was denied.

Giving such an instruction is the method used in the U. S. Courts for ending a case when the plaintiff's own testimony shows that he is not entitled to a verdict even though every fact which he has undertaken to prove should be true. It is equivalent to the ordinary motion for a non-suit in the State Courts.

The testimony of Mr. Cassidy showed that his drier operated substantially the same as the old Alden drier which he had seen before he made his alleged invention. That the difference between them was in the mechanism by which their operations were carried on. We claimed then and claim now that this testimony showed as a fact that the change which the plaintiff had made was not any change in the operation of the Alden drier, but that at the most he had only substituted equivalent mechanical devices for those which had already been doing the same work in the Alden drier.

We base this point upon the ground that the plaintiff's own evidence proved that the patent was invalid; and that as the patent was invalid no action could be maintained upon it.

This ground applies to the second claim of the patent only. The patent has two claims, but there was no proof of any infringement of the first claim and it has been conceded all the way through the

case that the defendant had not used any thing covered by the first claim and had not infringed the same. The whole struggle in the case is and has been over the second claim.

Our assertion that the plaintiff's own evidence proved that the patent is invalid as to the second claim is based upon one well defined rule of patent law, and upon the undisputed testimony of the plaintiff himself, corroborated, however, by other evidence.

The principal fact referred to is this, viz.:

Prior to the alleged invention of the plaintiff he had seen and knew the construction of a well-known fruit drier that was already in public use known as the "Alden Drier." That this Alden drier operated upon the same mechanical principle as did the plaintiff's drier, and contained devices for performing precisely the same operations as did the plaintiff's drier. That all the plaintiff did was to take the Alden drier and change it by taking out certain chains and lugs that were used for receiving and carrying upwards through the heated draft trays which carried the fruit that was being dried and delivering the same at the top of the drier, and substituting for such chains and lugs the stationary and movable posts with the spring catches, the combination of all which is covered by the second claim of the patent.

That the alleged invention therefore consisted solely in substituting for the chains and lugs of the Alden drier the mechanical equivalents of such chains and lugs which were used for producing precisely the same effects and results and none other than the chains and lugs of the Alden drier produced.

The rule of law referred to is this, viz.:

The substitution of mechanical equivalents for the devices or elements that are already in use in an existing combination of devices, whether such substituted devices produce better results or not, is but the exercise of mere mechanical skill, and is not patentable. This is a rule that has been declared and repeated and reiterated in a large number of cases by the U. S. Supreme Court.

In *Smith vs. Nichols*, 21 Wall., on the first half of page 119 the Supreme Court says:

"But a mere carrying forward or new or more extended application of the original thought, a change only in form, proportions, or degree, *the substitution of equivalents, doing substantially the same thing in the same way by substantially the same means with better results*, is not such invention as will sustain a patent. These rules apply alike, whether what preceded was covered by a patent or rested only in public knowledge and use. In neither case can there be an invasion of such domain and an appropriation of any thing found there. In one case every thing belongs to the prior patentee, in the other to the public at large."

This rule of law has been repeated and reiterated by the Supreme Court time and time again as well as by many of the Circuit Courts.

Roberts vs. Ryer, 91 U. S., 159.

Reckendorfer vs. Faber, 92 U. S., 354.

Penn. Railroad vs. Locomotive Truck Co. 110 U. S., 494.

Phillips vs. Detroit, 111 U. S., 607.

Morris vs. McMillin, 112 U. S., 249.

Stephenson vs. Brooklyn Railroad Co., 114 U. S., 154.

Dunbar vs. Myers, 94 U. S., 199.

Burt vs. Ivory, 133 U. S., 358.

International Tooth Crown Co., vs. Gaylord, 140 U. S., 62.

Butler vs. Steckel, 137 U. S., 29.

In consulting the foregoing cited cases as many illustrations of what facts the foregoing rule of law will apply to, will be found as the Court will care to examine. The foundation principle of it all is, that the knowledge belonging to existing mechanical skill belongs to the public and every mechanic, as well as the public has the right to use it, and no one mechanic, or any one else can deprive other mechanics or other persons from using what belongs to them, by obtaining patents for specific variations of mere mechanical skill which variations includes nothing but what any skilled mechanic knew how to make by applying to the subject his mechanical knowledge only, and without any exercise of the inventive faculty. Any mechanic knows how to make mechanical implements in many forms and when he intends to make any given implement in a new form he knows before he makes it what it will do because its new form is analogous to other forms already known and the change of form will produce only the change in result that the same change of form has produced in other well known implements. The same is true of combinations of devices. When a mechanic sees a machine at work and sees the various devices of which it is comprised, and sees what duty each device performs and how it performs it, and also sees the ultimate result of all the devices working in combination, he at once knows that he can substitute many other mechanical devices for those in the machine and produce the same results and by the same mode of operation. If he wishes to make a cheaper machine his knowledge of mechanics enables him to do it without any invention. If he wishes to make a stronger machine of the same kind he may substitute better materials or even better devices for doing the same corresponding work that one or more of the devices in the machine is doing and thus make a stronger machine because he already knows how to do it by using his knowledge of mechanics only. If he wishes to make a faster working machine his knowledge of mechanics enables him to do that without any invention because he already knows how. Making such changes by using only the existing knowledge and skill of mechanics does not constitute invention. It is different, however, if he makes an improvement that does involve invention, something

that the existing knowledge and skill of mechanics cannot reach without climbing higher than the present plane of existing mechanical skill and knowledge and discovering and using something, or creating something, that no one had before known how to make.

That the substitution of well-known devices for the devices in an existing machine and thereby obtaining the same result in kind, still leaving the machine doing the same work that it did before and doing it in the same way without any change in its ultimate results and with no change in its internal operations other than what would necessarily follow from the different operations of the substituted devices, and which different operations it was known would necessarily follow because of the different action of the substituted devices does not amount to invention, and a patent for so doing is invalid, and no action can be maintained for the infringement of such a patent. As for instance, a mechanic knows the operation of a lever and he knows the different actions of a wheel and axle. If he sees a combination of devices in which a lever is used, and in which a wheel and axle can be substituted, he knows at once that he can make the substitution; and he knows in advance that the combination will do the same work and produce the same result after the wheel and axle has been substituted that it did before, and he knows that the general operation of the machine will be the same as it was before, and that its internal operations will be changed somewhat because the operations of the wheel and axle which he has substituted is different from the operations of the lever for which it was substituted. Still he can make the change, using only his knowledge and skill as a mechanic, and without inventing anything. It is a common mode of attempting to appropriate the invention of real inventors by making mere mechanical changes in the forms of their machines and then claiming that they are not the same.

Now in the case at bar, before the plaintiff made any invention, he, the plaintiff, had seen the Alden drier; he had seen the trays of fruit put in at its bottom; he had seen those trays rise as required during the process of drying; he had seen that as fast as the lower one rose high enough to give the room that another one was put in its place on the lugs that the chain carried; he had seen that when the drier was filled with the trays of fruit that the tray of dry fruit at the top was taken out and the column of trays raised by the chains and lugs and another tray of green fruit put in at the bottom and that the drier was thus constantly kept full and the dried fruit taken from the top of the drier and the fresh undried fruit placed in the bottom. This mode of operation he did not change, *but appropriated it bodily.*

In appropriating the general plan and mode of operation of the machine, the only change made by him so far as the second claim

applies, was to substitute for the chain and lugs of the Alden drier the stationary and movable posts and spring catches of his patent.

In *Randall vs. B. & O. R. R. Co.*, 109 U. S., 482, the Supreme Court says :

“ It is the settled law of this Court, that when the evidence given at the trial, with all inferences that the jury could justifiably draw from it, is insufficient to support a verdict for the plaintiff, so that such a verdict, if returned, must be set aside, the Court is not bound to submit the case to the jury, but may direct a verdict for the defendant. *Pleasants v. Fant*, 22 Wall., 116 ; *Herbert v. Butler*, 97 U. S., 319 ; *Bowditch v. Boston*, 101 U. S., 16 ; *Griggs v. Houston*, 104 U. S., 553 ; Robinson on Patents, Sec. “ 1073.”

Heald vs. Rice, 104 U. S., 737, was a patent case that was tried by a jury. Many of the facts are stated in the opinion of the Supreme Court in deciding the case. On pages 737 and 738, the Court states the fact, that :

“ A bill of exceptions sets out the exceptions of the defendant to the rulings of the Court below, and all the evidence. The Court was asked at the close of the plaintiff’s testimony, and again when all the evidence on both sides had been introduced, to instruct the jury to return a verdict for the defendant; the refusal to do, which, amongst other rulings, is assigned for error; and thus the whole case on the merits is brought here for review, so far as they rest upon questions of law.”

The case at bar is in the same condition as was the case of *Heald vs. Rice*, and that, at the close of the plaintiff’s opening testimony the defendant asked for an instruction that the jury bring in a verdict for the defendant, and the Court refused the request. There was no subsequent testimony that made the plaintiff’s case any better for him than it was when he closed his opening testimony.

In the *Rice* and *Heald* case, exceptions were argued under three heads, and the second one of them was in effect that the testimony showed that the invention was anticipated by a former patent to one Morey. (See page 748 of the decision.) On page 753 of the decision, the Supreme Court proceeds to show that the Morey patent was, in fact, an anticipation of the *Rice* patent sued on. At the close of its decision in that case, the Supreme Court says :

“ The Court below, in its rulings upon objections to the introduction of the reissued patent of *Rice*, in its refusal to charge the jury as requested by the defendant, and in its charge as given, took views of the validity of the patent, on which the case of the plaintiff rested, which are opposed to those expressed in this opinion, and which necessarily resulted in the verdict and judgment against the defendant. For these errors the judgment must be reversed, with directions to grant a new trial; and it is so ordered.”

The case of *Fond du Lac County vs. May*, 137 U. S., 395, was a

case that was tried by a jury and taken to the Supreme Court on a writ of error. In that case, also, the defendant moved that a verdict be directed for it, which motion was made upon the ground that the patent was void for lack of novelty, and that the combinations described in it were not operative combinations and were old and well-known devices applied to similar uses. The motion was overruled and the defendant excepted. In its decision, the Supreme Court *examined the facts* of the case and decided that the patent was void. Page 402 of the case shows that the instructions were asked for and refused. On page 403, the Supreme Court says:

“ We are of the opinion that the *Court ought to have directed a verdict for the defendant, on the ground that the patent was void*; and “ that the judgment must be reversed.”

The next case in the same volume is *May vs. Juneau County*. It was another suit at law brought upon the same patent.

At the close of the testimony the defendant moved for an instruction to the jury to bring in a verdict for the defendant upon *other grounds* than that the patent was void. The Court granted the motion and the plaintiff carried the case to the Supreme Court on a writ of error. The Supreme Court affirmed the judgment and held that the Court was right in giving the instruction *because*, as the Supreme Court held, *the patent was void*. That although the instruction was not asked for upon that ground, still the *defendant could urge that ground at any time* and the motion was broad enough to cover the invalidity of the patent although that ground was not then distinctly urged. That “ want of patentability is a defence “ though not set up in an answer or plea.” Citing several of its own decisions.

Our object in referring to these authorities is to prove that when the testimony shows that the patent is invalid and the trial Court is asked to charge the jury to find for the defendant that it is error for such Court to refuse the instruction, and that the appellate Court will reverse the judgment entered in the plaintiff’s favor in such a case and order a new trial.

We also claim that when the testimony is construed as strongly as possible in the plaintiff’s favor and every fact which he undertakes to prove is taken to be true, if then the evidence proves the patent to be invalid, that the applying of the facts to the patent becomes a question of law, and if the lower Court refuses to do so and declare the patent void, when the undisputed facts so show it, that such refusal is an error for which the appellate Court will reverse the judgment and grant a new trial.

Believing that we have established this proposition by the authorities we will return to the presentation of the evidence and see whether or not the evidence in the case at bar does show the patent invalid so as to bring the case within the decisions to which we have referred.

The plaintiff's patented drier is built and operates as follows :

It has four stationary posts, one at each corner of the machine. It also has four movable posts, one of which is alongside of each one of the stationary posts. All of the posts are in a vertical position. A series of spring catches, one at some distance above the other, is fixed to each one of the posts. The upper end of these spring catches extend out from the posts so as to furnish a support for the fruit trays that are used to carry the fruit that is being dried.

The catches are pivoted so that they will turn back along the side of the post to which it is fixed and so allow an ascending fruit tray to pass it. The catches are fixed to the four stationary posts level with each other so that each set of four catches that are on the four posts will be level with each other and they will furnish a support for each tray near each corner of the drier. The catches are arranged the same way in the movable posts. Mechanism is employed to move the four movable posts simultaneously up and down far enough to carry each fruit tray upwards from one set of catches and deposit it on the next set of catches above, and then return for another tray.

The operation of the drier is as follows: A tray of fruit is set on the lower set of catches on the movable posts. The posts are raised and the spring catches in the stationary posts will be pressed back by the edges of the rising tray. When the rising tray that is carried upward by the movable posts reaches a point level with the upper ends of the set of catches in the stationary posts those catches will spring forward so that their upper ends will come underneath the tray and furnish a support for it to rest upon. The movable posts will then return downwards and receive another fruit tray. While the movable posts are returning downwards their second set of catches above will fall back so as to pass the edges of the tray that was first carried up, and will then spring forward so as to furnish supports for the tray when the movable posts are again raised. The movable posts will then be raised and the two trays will then be carried upward far enough for each one to pass one set of the catches in the stationary posts when the trays will be supported by them as the movable posts are again moved downwards to receive another tray. This operation will be repeated until all the catches on the stationary posts are filled with the trays. The operation will be carried on slowly enough to allow the fruit in the upper tray to become thoroughly dried when it reaches the top of the drier where it will be removed from the drier. As fast as the trays are removed from the top of the drier other trays of fresh fruit are replaced in the bottom, and the drying operation is continued as long as desired. This class of driers have been denominated "stack" driers.

The plaintiff testified that he was a mechanic and had formerly lived in Wayne county, New York. That he had been in mechanics

since he was fourteen years old, working with his father. His father was a mechanic and he worked with him a good many years. He worked as a mechanic in New York, and at the Golden State and Mners' Foundry in California, and also at the Vulcan. Record, side page 21.

His age was sixty-nine. He came to California in 1852, and had lived in Petaluma since 1858. He came from Wayne County, N. Y. In that county there was no fruit drying except by the sun. Record side pages 15 and 16.

The plaintiff himself testifies that the Alden drier was the *first* drier of the kind and that he saw it and it operated in carrying the trays up and in drying the fruit the same as did his own drier. Beginning at the middle of page seventeen of the Record his testimony is as follows:

“The *first fruit drying machine* where the trays of fruit were put “in at the bottom and carried gradually to the top, one above “another, *was the Alden machine*. I saw that in 1874 or 1875, “somewhere about that time.

“Q. What is the difference in operation between that machine “and yours?

“A. I think I can explain this thing with this model, plaintiff's “Exhibit No. 2. I suppose you all know what an endless chain is. “It is formed by links, and these flat links are fetched together and “run over pulleys or sprocket wheels as this endless chain comes “up. They are far enough apart to keep the trays separate. There “would be an arm to each one of those links. As it comes up on “the sprocket wheel they would be four square or six square or “eight square, wide enough to accommodate the link. The sprocket “wheel is where the endless chain runs over at the top and one “corresponding at the bottom. As these links come up there is a “projection on the link that comes through, perhaps a couple of “inches, to receive the tray as you insert it. As you put that in “with mechanism, those chains all move together. There is a “chain on each one, so that when you apply the mechanism, each “chain moves in unison. As the next link comes around, you put “in another tray and continue until it is full.

“A JUROR. Q. These arms of the chain would project out?

“A. Yes sir, and that would hold the tray until it got to the “top, and the tray then would be removed before it struck the “sprocket wheel. When it struck the sprocket wheel one portion “of the chain would be going down outside while another portion “would be coming up inside. That is the way the Alden machine “is operated.

“MR. WHEATON. Q. So far as drying the fruit is concerned, “and the movement of the tray is upwards, what is the difference “between the Alden machine and your machine?

“A. *It would be the same*. I will not say the movement of dry-

“ing would be the same. The movement is different.

“Q. I speak of the movement of the tray alone. *Would they not move up the same in one case as in another (the other) provided the machine was worked at the same rate of speed and same intervals of time?*

“A. *Yes, sir.*

“Q. The trays would be carried up *just the same* in one machine as they could in another (would in the other)?

“A. *Yes, sir.*

“Q. In neither case are the trays constantly moved up, but are carried up step by step, and allowed to remain there until the fruit is dried awhile, and the bottom one taken out, refilled, and put in at the bottom and carried up another step until the next one is sufficiently dried to remove?

“A. Yes, sir. Between the times of movement of the machine to carry a tray up one step from fifteen minutes to half an hour intervene, owing to the variety of fruit and the amount of heat.

“Q. Are the furnaces in the Alden machine capable of being arranged as in your machine?

“A. I don't know; the furnace certainly is at the bottom, but what kind of a furnace they use I don't know.

“Q. What other drying machine of this stack, or capillary kind, is there that you know of?

“A. That is the only one I ever saw outside of mine, at that time. I have since seen them with those gravitating catches, but not before. The Alden machine is the only machine that I saw outside of mine.

“Q. Would you not understand that your invention was to substitute this kind of movable posts and these catches for the endless chain of Alden for the purpose of carrying up those fruit trays?

“A. I did not so intend it. I intended to carry up my fruit trays by those springs, without any regard to what Alden or any one else did.

“Q. Did you make any other change at that time that you can think of in fruit trays, so far as the second claim of your patent is concerned, other than to substitute this kind of catches and posts for the endless chain with the arms on, which are used in the Alden drier?

“A. I have no recollection of ever having made any change from what you see here.

“Q. What change did your invention make in fruit driers?

“A. It had a tendency of rather revolutionizing the fruit drying business, for immediately after I got my patent most every one was using these devices East. They were using my catches and sliding posts. *The Alden had the name of being a well-known and celebrated fruit drier. My drier would dry the same as the Alden. I don't suppose it would dry any different kind of fruit. I don't think*

“ it would dry it in any different manner.”

On pages 23, 24, 25 and 26, his testimony is even still stronger than that just quoted, in showing that his posts and spring catches are but the mechanical equivalents of the Alden chains and lugs. *They both did the same kind of work ; they both did it the same way—* that is, by receiving the loaded trays in the bottom of the driers, one at a time, and carrying them to the top at any speed desired and with any stoppages which the operator chose to make—*one would do everything that the other would do, and neither would do anything that the other would not do.* On page 24, the plaintiff’s testimony is strong in showing that his posts and catches fill every one of the legal requirements that made them the mechanical equivalents of the chains and lugs of the Alden drier.

Near the bottom of page 20 of the Record, Mr. Cassidy testifies that he saw five of the Alden machines in operation in San Lorenzo in 1874. A man named Pile had charge of the Alden drier in California, and he went East in 1875.

The plaintiff’s patent was applied for March 8th, 1875. (See heading of the patent, Record, page 9.)

On pages 82 and 83 of the Record, Mr. Cassidy puts in a crude drawing and says that he made it and got up that idea about the latter part of March or first of April, 1874.

Other patents of stack driers of much older date were put in evidence by the defendant, but there was nothing put in evidence that tended to contradict, or in any way relieve the legal effect of the plaintiff’s testimony, which was, that the *Alden was the first* drier, and that the plaintiff had seen it before he made his invention, that it “ *was a well-known and celebrated drier,*” and that it operated the same as did the plaintiff’s dryer in receiving the fruit trays, in carrying them upwards, and in drying the fruit upon them.

We submit to the Court whether the facts of this case does not exhibit an effort on the part of the plaintiff to *appropriate bodily* the principle and mode of operation of the Alden drier and claim it as his own, and that the substitution of the posts and catches for the chains and lugs of the Alden drier, and the obtaining of his patent, therefor were not the means by which he has attempted to make such appropriation. In the Record from page 11 to page 16, he has described the operations of the devices in his driers just as though those operations were original with him instead of being taken from the Alden machiné, and when in addition to this, we look at his answer on page 18, given in answer to the question as to whether his invention was not the substitution of the posts and catches for the endless chain of the Alden drier, he says: “ I did not “ so intend it. I intended to carry up my fruit trays by those “ springs, *without any regard to what Alden or anyone else did.*” Is it not plain that his effort is to appropriate to his exclusive use and as his exclusive property the prior inventions of others which he

found in use and which were no part of his discovery. While he lived in Wayne County, although he was a mechanic, he did not think of making fruit driers. After he found the Alden driers at work in California, he substituted the posts and catches for the Alden chains and lugs "without any regard to what Alden or any one else did," and then sent his agent back to that same Wayne County, and put his drier which was substantially the same thing as the "well-known and celebrated" Alden drier, and charged one hundred dollars royalty for what he had thus *found and appropriated* in California, "without any regard to what Alden or any one else did."

Applying to these undisputed facts the rule of law which we have shown to be established by so many decisions of the Supreme Court to the effect that the mere substitution of mechanical equivalents for devices already used in an existing machine is not invention, and that a patent granted for the same is totally invalid; and applying also the other rule that when all the facts in the case proved that the plaintiff's patent was invalid that it was the duty of the Court to instruct the jury to find a verdict for the defendant, and we cannot see why our second exception is not fatal to the plaintiff's case.

We think that we have shown to a mathematical certainty that, taking all of the testimony that is in the case in the plaintiff's favor as true, the fact is established that the patent was totally invalid and that there was no question except to apply the facts to the plaintiff's patent and decide that, as a question of law, those facts made the patent invalid; and that under such circumstances it was the duty of the Court to direct the verdict as asked for by the defendant. While we do not intend to waive any of the exceptions between the second and tenth we will not stop to make an argument upon them. We consider that the instructions present substantially the same questions, and will pass to the instructions.

In discussing the foregoing second exception we had to assume that every fact was as the plaintiff claimed it to be so as to leave nothing for the jury to pass upon. In discussing the charges that were given or refused no such assumption exists. The giving or refusing of instructions is based upon the idea that the jury are to decide upon the testimony and find what the facts are and that the charges guide them in applying the law to the facts as they shall find them to be and, from such application, to reach a correct ultimate conclusion.

The defendant introduced in evidence a patent to M. P. Smith that was granted in 1870 for a stack drier that received the fruit trays at the bottom and carried them to the top, and, as we claimed, operated on the same principle as the plaintiff's stack drier. At the four corners of the Smith drier there were four vertical screws which did the lifting of the trays. These screws had very wide

threads cut in them and the ends or edges of the fruit trays reached into these threads and the trays were carried upwards as the screws were revolved. When the drier was filled with trays, the top tray would be removed and a fresh tray put in at the bottom and the work carried on in that way.

Defendant claimed that the posts and catches of the plaintiff's drier were but mechanical equivalents of the four corner screws of the Smith drier.

This Smith patent is shown and explained in the Record from page 51 forward. Its drawings are between pages 50 and 51.

The defendant also put in evidence a patent granted to Foote and Smith on the 26th day of March, 1872. This patent described a drier that was like the Smith patent for receiving and carrying the fruit trays, but its furnace and draft arrangements were such that the heated air passed downwards through the drier instead of passing upwards as in most other stack driers. Record pages 76 to 80.

Defendant also put in evidence a patent granted to Alfred Edwards on the 7th day of January, 1873. This was also a stack drier. It had four endless belts, one at each corner. Arrangements shown as projections in the drawings were attached to the belts for receiving the trays, which were called *plates* in the patent. These were projections reaching out from the belts at intervals similar to the lugs of the chains in the Alden drier. In this Edwards patent the plates carrying the fruit were placed in at the *top* of the drier and *carried downwards against the draft of heated air*.

It will be noticed that every one of the last three patents were for stack fruit driers. In two of them the fruit trays were received at the *bottom*, one at a time, and were carried upwards and more trays put in at the bottom until the stack was filled. In these two each tray was put in at the bottom and taken out at the top. In these two the trays were carried upwards the same as they are carried upwards by the plaintiff's drier, and were so carried up by devices of which, defendant claimed, the plaintiff's posts and catches were equivalents only. In one of them the draft was upwards the same as in the plaintiff's, while in the other one the draft was downwards. In the third patent were the four belts, which evidently could be run either up or down, but were described as running downwards. This was also a stack drier but it *carried the fruit trays downward* against the draft of heated air.

It will be noticed that each one of these three driers were several years older than even the crude sketch that was made by the plaintiff in 1874, and that in these three driers were found the general combinations of the plaintiff's drier made up of devices of which the plaintiff's posts and catches were only mechanical equivalents. Also, that every principle and mode of operation was incorporated in these driers and in their action that can be found in the plaintiff's.

iff's drier, *and considerable more*. In addition to the mode of operation shown in the plaintiff's drier, there was found in one or other of the said three driers a *downward draft of hot air*, and in another a *downward movement of the fruit trays* against the rising draft of heated air.

Even without counting the Alden drier there was nothing left for the plaintiff to *invent* when he commenced in 1874. All that he could do was to *appropriate* what then belonged to prior inventors or to the public. No mode of action is found in his machine that was not in operation long before in some one of the last three patents mentioned. Nothing new is shown in the plaintiff's patent *except the substitution of mechanical equivalents* for doing the same work that other mechanical devices had long before been doing in earlier machines. At least, this is what the defendant claimed the proof established, and it had good reason to so claim.

Besides the three patents last mentioned, the defendant put in evidence a patent that was granted to J. O. Button for a stack fruit drier. This patent was applied for July 20th, 1874, and was granted September 22nd, 1874.

This Button patent was issued between five and six months before the plaintiff's patent was applied for. The Button patent was applied for more than seven months before the plaintiff's patent was applied for. Considerable testimony was taken showing that the Button machine was made to operate the same as the plaintiff's except when one tray was lifted up from the bottom and deposited upon the catches above and the next tray was put in under it and lifted up to the same catches that the upper tray from that time forward rested upon the lower tray and was carried up by it. When the stack was full in the Button drier, the trays rested one on top of the other except at the bottom where next to the lowest tray rested upon a system of catches which were spring catches like the plaintiff's. The trays were moved upward by a lever arrangement that lifted the bottom tray and placed it on the catches above so as to make room for the next tray, the operation so far being the same as in the plaintiff's drier. (See evidence on pages 70, 71, 72, 88, 89, 90, 95, 96, 97, and description in Button patent on page 64.

Even the plaintiff's own expert testifies that the lower part of the lower catches of the Button patent were substantially the same as the spring catches of the plaintiff's patent. Upon this fact we do not understand that there was any dispute or any conflict in the testimony. This left the plaintiff anticipated even as to the catches themselves; and although there were not so many of them, as are shown in the drawings of plaintiff's patent. We claimed, however, that as there were enough of them to raise the lower trays of fruit one step high, that all the plaintiff did over what Button did was to put in more sets of the catches for the purpose of making them *repeat* the same kind of operation; and that this was not and

could not be a patentable invention. If this was so it left the plaintiff with nothing new even in his substitution of mechanical equivalents.

The foregoing questions were questions that we claimed should have been left to the jury to decide and that they should have had proper instructions, so that when they had concluded as to the disputed facts that they could correctly apply the law to those facts and reach a correct conclusion in their general verdict.

We here call the attention of the Court to the second claim of the plaintiff's patent and ask it to say whether more than one set of stationary catches and one set of movable catches are called for by the claim. Of course we admit that these eight catches are necessary for receiving the tray and carrying it up one step and leaving it deposited in its position one step upwards. These eight catches are all that are used in this one operation, and they are all that the terms of the claim require. Now suppose the patent to be valid and the drier to have been the first of its kind, would not the claim be infringed by a drier that contained the stationary posts, the movable posts, with four catches on the stationary posts and four on the movable posts? The tray would be received on the catches on the movable posts and carried up above the catches on the stationary posts and left there as the movable posts returned down to receive another tray. If one full double set of these catches does not fill the calls of the claim how many set would it require? Would a person have to use twenty sets, or ten sets, or five sets before he would infringe? Since no number is stated in the claim other than one double set of eight catches, and as that number performs one of the entire operations that is performed by the catches, no matter how many are used, we believe that the claim of the patent is filled by that number of catches, and that if the patent is valid that any person using that number of catches with the several posts called for would infringe the patent. If this is so then the Button patent was a full anticipation of the plaintiff's patent.

The defendant also introduced in evidence the file wrapper contents of the Patent Office, showing the Record of the proceedings had in, and upon, the plaintiff's application for his patent. This is in the Record from page 31 to the top of page 41.

As plaintiff first asked for his patent he, in his second claim asked for the combination "with the spring or other catches," etc. The Patent Office rejected the claim and referred to the Button patent as anticipation of it. These things appear on page 34 of the Record.

The plaintiff then amended his application and changed the second claim by leaving out the words, "or other catches," and asking for the spring catches alone.

Now this is one of the cases where the field was covered before the plaintiff got into it. There was very little left, if anything, for him to

invent. Every thing in his second claim was already in use, even his springs. He accepted his patent with the words, "or other catches," erased, not because he did not want them but because the Patent Office said they did not belong to him, and the Patent Office refused to allow them to him. The Supreme Court has decided in very many cases that in such instances the patentee cannot accept his patent with things stricken out of what was in his application and then afterwards come into Court and claim the things thus stricken out of his application and have them allowed to him by the Court, either upon the ground that they are mechanical equivalents of what was allowed to him or on any other grounds.

In *Shepard vs. Carrigan*, 116 U. S., beginning on page 597 the Supreme Court says:

"This fact, and the file wrapper and contents of which we have stated the substance, make it clear that the claim and specification of the McDonald patent must be construed to include, as their language requires a fluted or plaited band or border as one of the essential elements of the invention. *Without this element the patent would not have been issued.* The Patent Office decided that without it the invention had been anticipated. Where an applicant for a patent to cover a new combination is compelled by the rejection of his application by the Patent Office to narrow his claim by the introduction of a new element, he cannot after the issue of the patent broaden his claim by dropping the element which he was compelled to include in order to secure his patent." Citing a list of authorities.

So in *Sargeant vs. Hall Safe and Lock Co.*, 114 U. S., on page 86, the Supreme Court says:

"In patents for combinations of mechanism, limitations and provisions, imposed by the inventor, especially such as were introduced into an application after it had been persistently rejected, must be strictly construed against the inventor and in favor of the public, and looked upon in the nature of disclaimers."

See also

Legget vs. Avery, 101 U. S., pages 258, 259 and 260.

Mahn vs. Harwood, 112 U. S., page 359.

Cartridge Co. vs. Cartridge Co., 112 U. S., page 644.

James vs. Campbell, 104 U. S., page 378.

Goodyear Dental Vulcanite Co. vs. Davis, 102 U. S., page 228.

Sutter vs. Robinson, 119 U. S., page 541.

Burns vs. Meyer, 100 U. S., latter part of page 672.

Crawford vs. Heysinger, 123 U. S., pages 606 and 607.

Our position is that under these authorities the plaintiff cannot claim as elements of his combination any catches except *spring catches*. Under the rejections of his application for a patent by the Patent Office he struck out the words, "or other catches," and by so

doing obtained his patent. He cannot now come into Court and claim what *he thus struck out of his claim*.

Of course we do not pretend but that the gravity catches are the equivalents of spring catches. The real points are two; one is that the plaintiff cannot cover equivalents of the elements of his combination for the reason that all that he did himself was to substitute his particular devices for other devices which he already found in the same kind of combination. The same combination with other equivalent elements *already existed and he did not invent it*. His claim therefore must be limited to his particular devices because *that is the extent of the change he made*. The original inventor of the combination could invoke the doctrine of mechanical equivalents, but a mere improver who only changes the devices is not an original inventor of the combination and he cannot claim equivalents of the elements. Those equivalents *belonged to the first inventor and not to the improver*.

This whole subjected is treated at great length in *Morley Machine Co. vs. Lancaster*, 129 U. S., from page 272 to 283, where the authorities are presented in the opinion of the Supreme Court.

McCormack vs. Talcott, 20 How., page 405.

Railway Co. vs. Sayles, 97 U. S., page 556.

Grier vs. Wilt, 120 U. S., was a decision on a fruit drying patent, and is interesting as showing how a narrow patent is to be construed.

Our other real point referred to is that as the defendant only substituted one class of devices for another class in a known combination of devices, such substitution could not constitute a patentable invention, and the plaintiff's patent *is void* on that account. That it cannot be sustained even by giving it a very narrow construction and limiting it to spring catches as contradistinguished from other catches. This point is covered by the authorities already cited, which hold that the mere substitution of mechanical equivalents does not amount to a patentable invention, even though better results are obtained by such substitution.

There is one feature of this case that is reached by the decision of the Supreme Court in *Railroad Co. vs. Mellon*, 104 U. S., 112.

In both cases the applicant filed his specifications with a certain claim that would suit the description as contained in the specifications filed. In both cases the Patent Office refused the claim and after the claim was changed so as *not to fit the description*, the patent issued leaving in the specifications the original description. In both cases, the patentee claimed according to the original description, which the claim no longer fitted except by "construction." In the case referred to, 104 U. S., on page 118, the Supreme Court says :

“ In this case the *description* of the appellee’s invention is much “ *brouder than his claim*. It seems quite clear from the present “ form of his specification, and from the fact that his application “ for a patent was twice rejected, that he was compelled by the “ Patent Office to narrow his claim to its present limits before the “ Commissioner would grant him a patent. In doing this, he “ *neglected to amend the descriptive part of the specification*. He cannot “ go beyond what he has claimed and insist that his patent covers “ something not claimed, merely because it is to be found in the “ descriptive part of the specification.”

The change made in the claim in the case cited was only changing the claim so as to claim a flange with a *rounded* corner, and he thereby was held to have *excluded a flange with an angular* corner, although one seems practically to have been the same thing as the other.

We believe that the instructions given at the request of the plaintiff, which are shown under our 38th and 39th assignments of error, are directly opposed to the law as laid down in the authorities which we have cited to the effect that the *patentee is bound by his claims*, and that if he strikes out part of what he originally claimed after his application is filed *and accepts his patent with those portions out* that he cannot afterwards go into court and assert that he may still *claim the very things thus stricken out by him* while in the patent office. Especially is the instruction given that is shown under our 39th assignment of error directly against the case just cited of *Railroad Co. vs. Mellon*. Indeed, if the Supreme Court was itself intending to overrule this decision it could hardly have chosen stronger language in which to do it than is contained in the instruction shown in said 39th assignment of error.

The last case cited, holds, as do many others that the scope of patents must be limited to the invention covered by the claim. That though the claim may be illustrated, it can never be enlarged by the language of the specification. (See page 118 of the decision ; also, *McLain vs. Ortmyer*, 141 U. S.; last two lines on page 423, and pages 424 and 425, and cases there cited.)

The instructions asked for by the defendant and covered by the tenth, eleventh, twelfth, thirteenth, fourteenth and fifteenth assignments of errors, were in accordance with the rules of law which the foregoing authorities sustain, and the refusal of the Court to give each of them, we respectfully submit was error.

We cite to sustain the instruction asked for and shown in the tenth assignment of error the following additional authorities :

Rowell vs. Lindsay, 113 U. S., latter part pages 101 and 102.
Corn Planter Patent, 23 Wall., page 224.

The instructions asked for shown in our sixteenth and seventeenth assignments of error involve the same questions of law that were

involved in our motion for an instruction to the jury to find for the defendant and the same authorities which we cited upon that point apply to these. We think that it was error in refusing each of the last two instructions shown in said assignments of error, sixteen and seventeen.

The instructions as asked for by defendant and shown under assignments of error numbers eighteen to twenty-five inclusive, refer to the Button drier as an anticipation. The Button drier was a very successful drier. The Button driers were made and sold by the witness Wightman, and there were more of them used in Sonoma County than of all other driers put together according to what the testimony shows. The testimony of Mr. Wightman—Record pages 47 to 51—describes the Button drier and its operation, and it seems to be the same as the plaintiff's, except that its catches do not extend to the top, but only operate with the lower trays. The description of the Button patent on the first half of page 44 of the Record could almost be substituted for the plaintiff's drier, and the first claim of the Button patent, on the same page 44 of the Record, would almost apply as the second claim of the plaintiff's patent. Even the plaintiff's expert, L. W. Seely, says that if the claim of the plaintiff's patent should be held to apply only to the lower set of catches in his patent that then he should think there was exactly the same combination in the Button as in the Cassidy patent. Record near bottom of page 97. Much of Mr. Seely's testimony shows the bearing of the Button patent on the case.

We claim that the second claim of the plaintiff's patent includes only the lower set of catches; that a use of the lower set of catches with the other elements of the combination would infringe the patent whether any more of the catches were used or not; and this for two reasons. First because that is in accordance with the language of the claim. Second when the lower set of catches are used with the other elements of the combination, there is a complete combination used that performs one complete operation in receiving and lifting the tray to the set of catches above, and that no other operations are performed by the combinations except to keep repeating this one step. That the additional catches are only a multiplication of catches for repeating this one operation, and that such multiplication of catches makes an aggregation and cannot constitute any part of a patentable combination.

An aggregation is not patentable. If more parts are included than operate together in creating a joint action between them, then the whole combination becomes an aggregation and not a patentable combination.

Robinson on Patents, Sections 155 and cases thereunder.

Pickering vs. McCullough, 104 U. S., pages 317 and 318.

If we are right in this contention the Court should have given

the instructions asked for by us which are shown in the 21st, 22nd, 23rd, 24th and 25th assignment of errors.

In the instruction that was given shown in our 35th assignment of error the Court gave a correct definition of what constituted a mechanical equivalent. In that instruction as well as in the further instructions shown in assignments of error numbers 36, 37, 38, 39 and 40, the Court instructs the jury in effect that if the defendant uses all the elements of the plaintiff's combination except that he substituted mechanical equivalents for the spring catches that it infringed the patent. To this line of instructions in a case of this kind we object upon the ground that this is one of the cases in which the law of mechanical equivalents does not apply. All that plaintiff did himself was to substitute equivalent devices in combinations of devices which he found in the Alden drier and which existed in several other patents long before the plaintiff entered the field of invention at all. His drier did not develop any new mode of operation at all. Upon this proposition of fact there is no conflict, the evidence being that of the plaintiff himself, corroborated by others. We believe the rule of law upon this subject of mechanical equivalents, when boiled down to an essence, to be just this, viz.: So far as an inventor develops any *new mode of operation* by his invention the doctrine of mechanical equivalents applies, and any subsequent constructor who uses mechanical equivalents or substitutes (which are the same things), for the particular devices which the original inventor has used in applying his invention to practical use is an infringer; but that in so far as a second patentee has only reproduced an old effect or reproduced the same operation which he already found and appropriated by the substitution of mechanical equivalents or substitutes, he is not entitled to invoke the doctrine at all. Usually a mechanical invention develops some new mode of operation to a greater or less extent. If it does not the invention is limited in its work to the repetition of what had been already done.

If there is nothing new accomplished in mechanical operation it is because the same thing has been done before. Now, if a mechanic comes along and sees a certain combination of devices doing a particular part of the work in a machine and conceives the idea that he can take out one of the devices in that combination and put another in its place that will do the same work, and he acts on this conception and changes the devices, what has he done except to take out one device and put in another to do the same work? Suppose the owner of the first machine had a patent upon the particular combination that the second man found there. Of course the second man had not invented that combination and had not discovered the action that would be obtained from it or that it would do the desired work. Such first inventor had developed and discovered all of these things. The second one—whom we will call an "improver," as that

is what they generally call themselves, and there are many of them—did not discover or produce any new effect that could not be produced by that combination. He only thought after he saw what it would do that one of the devices which he found there could be taken out and another put in its place and that the combination would still do the same work that it did before. By what rule, of right, or reason, could such improver claim that *he* had acquired a right to all other mechanical equivalents of the original device which he had removed. He only substituted *one* mechanical equivalent for the device removed. *This was the extent of his invention.* Why then should he be given the right to say that no one else should not remove from that original combination the same device which he had removed and substitute for it some other equivalent of it which he had not thought of, or if he had thought of it he did not patent it. The authorities are that he has no such right, that as he is but an improver he cannot suppress other improvers.

Look at the same question in another light. The inventor of the original combination had an undoubted right to all mechanical equivalents which might be substituted to do the same thing as did the devices used by him in that combination. Now, there can only be one valid patent for one invention. What would be a mechanical equivalent of the device used by the inventor of the combination would also be a mechanical equivalent of the device which the improver had substituted, because those two devices were mechanical equivalents of each other. As there could be but one patent that would cover the same invention, and as the inventor of the original combination would, by his patent, cover all mechanical equivalents of the several devices used by him whenever organized into that combination, the improver could not by his patent also cover them. One patent must stop where the other begins and the second patent cannot begin until the place is reached where the first one stops.

Possibly this illustration may show the reason for the rule which the Supreme Court has so many times repeated that the party, who merely substitutes equivalents for what he sees in use, cannot sustain his patent for the reason that it does not cover any patentable invention. At any rate we think we have shown both by authority and reason that in this case the plaintiff's patent could not cover mechanical equivalents. At least it should have been left to the jury in some form to say whether there was any new mode of operation developed by the plaintiff's patent and they should have been instructed that if there was not in that case the patent would not cover mechanical equivalents. As the instructions stand the jury were not allowed to say anything as to whether the invention was or was not of a primary character, but were in effect *instructed* to give the patent the same force as though it was for a primary pioneer invention.

Upon the question of damages the defendant complains of errors shown under nine of the assignments of errors, viz.: from assignment of error number twenty-six to number thirty-four, both inclusive.

There are various methods of proving damages in a patent suit. These are presented in Walker on Patents, from Section 555 to Section 571. Also, in Robinson on Patents, from Section 1049 to, and including, Section 1071.

In this case, the plaintiff attempted to establish damages by proving that he had an established license fee for his invention, and that he was entitled to recover such license fee as his damages in this case. The defendant denies that there was *any* evidence of any established license fee for the part of the invention that was covered by the second claim of the patent.

The law is, that, if the plaintiff can show that he has an established license fee for the use of his invention, such license fee may be the measure of damages in a suit at law. The defendant complains of the instructions that were given upon this branch of the case, and also to the refusal to give others that it asked for.

The plaintiff proved that he had given two agents the right to make and sell his driers in the Eastern States for one hundred dollars for each drier. That he divided the one hundred dollars with the agents, so that he received fifty dollars on each one of the driers. He could not tell how many driers were sold. It was a great many years ago. But he had received from one of the agents two or three hundred dollars and "may be a little more." Another agent undertook to sell the driers in Oregon on the same terms, but without any results to the plaintiff. (See Record, pages 16 and 17.) The last royalty received by the plaintiff was in 1885, six years before the trial. (Record, page 30.)

As far back as 1880, the plaintiff had advertised his drier and made great efforts to introduce it into general use in Sonoma County, which was the county in which he lived. After all his advertising and efforts, there were only four of his driers built in all those years in Sonoma County, and three of those the plaintiff himself owned in whole or in part. Only one was made and used exclusively by any third party. (Record, pages 98 and 99.)

On page 99, the plaintiff testifies that the royalties he received in the East were for "fruit trays." If this was so, they were not royalties under his patent at all, since no claim of his patent covers fruit trays. We will present the argument however in the most favorable light in which the other portions of the plaintiff's testimony places it for himself, and consider the facts as though the royalties were paid, for the driers that were made under his patent.

Under the law where a patentee owns several patents on one machine and grants licenses to make and sell machines that are covered by all of his patents, and an infringer afterwards makes and

sells machines which infringe a part of those patents but not the whole of them, the patentee cannot claim as the measure of his damages for infringement of a part of his patents the royalty which he received for the use of all of his patents.

The same is also the rule in cases in which the patent in suit has several claims and the patentee has an established royalty for the use of the entire patent and an infringer does not infringe the whole of the claims but only a portion of them. In such cases the plaintiff cannot apply as the measure of damages for the infringement of a portion of the claims of his patent the royalty which he receives for the use of all his patent.

Before a royalty can be accepted as a measure of damages for an infringement it must appear that it was an *established* royalty. An occasional sale is not enough. It is not enough that the patentee has offered to sell rights at a fixed rate, but it must also appear that others had purchased at that rate *until the rate had become uniform* and the sales had been frequent enough so that the price could fairly be said to have been agreed upon, between the patentee and the public as the value of the invention.

Again when a royalty has been paid for the use of the invention for a *great length of time* it will not be the measure of damages for an infringement which lasted for only a portion of the time.

Robinson on Patents, Sec. 1057 and cases there cited.

Rude vs. Westcott, 130 U. S., 152.

Walker on Patents, Sec. 557 and citations there made.

Colgate vs. Western Electric Co., 28 Fed. Rep., 147.

Vulcanite Paving Co. vs. American Art. S. P. Co., 36 Fed. Rep., 378.

Adams vs. Bellaire Stamping Co., 28 Fed. Rep., 360.

Walker on Patents, Sec. 563, and citations there made,

Black vs. Munson, 2 B. and A., page 626.

Proctor vs. Brill, 4 Fed. Rep., 415.

Wooster vs. Simonson, 16 Fed. Rep., 680.

Moffitt vs. Cavanaugh, 27 Fed. Rep., 511.

The last instruction given, shown in our 41st assignment of error, was to the effect that if the jury found from the evidence that the plaintiff had established a fixed uniform royalty for the use of his invention by others and had collected the same from others *in several instances* that then such royalty was the proper measure of damages.

We claim that this instruction was faulty. It left it for the plaintiff himself to *fix* the royalty and laid down the law to be, that, if he had collected the same in *several instances* from other persons that that was enough. This is not in accordance with the law as laid down by the authorities before cited. According to the instruction it would make no difference that the established royalty

had been abandoned. It would make no difference that it had only been paid in a few instances. It would make no difference that it had never been established in California, but had only been collected in the East, which was another country three thousand miles away from where the defendant had used the invention. It would make no difference that the royalty paid in the East so many years before gave the right to use the invention for *more than eight years* while the defendant could not use it, from the time it commenced until the patent would expire, more than about *three years* and that it had not used it two years when the suit was tried; and it would make no difference that the royalty had *not* been "paid by such a number of persons as to indicate a general acquiescence in its reasonableness by those who have occasion to use the invention." *Rude vs. Wescott*, 130 U. S., page 165; and worse than all; it made no difference that the royalty had been fixed for the *entire patent* while the defendant confessedly had *only used one part of it*.

The jury brought in a verdict for thirteen hundred and fifty dollars, and judgment was entered accordingly. Record, page 7.

There was no proof of any injury to the defendants' business on account of the driers built and used by the defendants, nor was there any proof of any profits or savings made by the defendants. So that it must have been the instructions given on the subject of royalties that the jury based its verdict upon.

It is true that the plaintiff testified that the selling price of the driers that he had made or caused to be made was two hundred and fifty dollars, and that the cost of them was one hundred and twenty-five dollars. Record, page 13. But there was no evidence that if the defendant had not built the driers that it would have purchased them of plaintiff. Neither was there any evidence that the particular portion of the driers that the defendant used was the special feature that controlled the market for the drier, nor was there any evidence that the drier controlled the market for fruit driers. On the contrary the evidence was quite the other way. The jury had no right to base their verdict upon this part of the evidence, and evidently did not do so. Both parties, as well as the Court, evidently considered that no damages could be recovered except under the theory of an established license fee. No instructions were asked by either party or given by the Court that were based upon any other theory or rule of damages than that of an established royalty.

Neither will a royalty paid in one part of the country be a measure of damages for an infringement committed in another part of the country. Neither will a royalty paid at one time be a measure of damages for infringement committed after that royalty has been abandoned.

Walker on Patents, Sec. 558.

Applying these rules to the plaintiff's own testimony and con-

sidering every thing as proved to which he testified, and also construing his testimony as favorably towards himself as its language will permit, and it was evident that the instructions asked for by the defendant from and including the one shown under the twenty-sixth assignment or error to and including the one shown in the thirty-fourth assignment or errors ought to have been given, or certainly some of them.

It was conceded all the way through the trial that the defendant had not infringed the first claim of the patent. The plaintiff's testimony showed that he had received the royalties that he did receive for the *entire right* of making and selling the *entire machine including what was covered by both of the claims of the patent*. Not the least effort was made to prove that any price had ever been fixed by the plaintiff or paid by any one for the right to use what was covered by the second claim of the patent. Not a particle of testimony of that kind was offered in the case. With the admission that the defendant had not infringed one of the claims of the patent, and with no proof whatever of the value of the other claim which was alleged to have been infringed, and with no proof of any other form of damages resulting to the plaintiff from the infringement, we think that the thirty-second instruction asked for by us ought to have been given.

As there was no proof of any license fee ever having been paid to the plaintiff in California, and no proof of any license fee having been paid since 1885 in the east, and as the defendant had not built its driers until the year 1890—Record page 64—it could not be said that the license fee paid in the east more than five years previously could in law be applied as the measure of damages in California five years later. Evidently the eastern royalty had long been abandoned; probably because no one would pay it. None had been paid since 1885 and that constituted an abandonment of it, at least on the part of the public. These being established as undisputed facts the applying of the established facts to the law and deciding what the rights of the parties under them were was a question of law. We think that we were entitled to have the 27th instruction which we asked for given. Also the 29th.

As it was a conceded fact that the defendant had not infringed the first claim of the patent, and no proof was introduced showing any royalty paid for the use of the second claim we were entitled to have the Court give the instructions asked for as shown under the 28th, 30th and 33rd assignments of error.

The instructions shown in the 31st, 32nd assignments of error are but elementary and should have been given.

Gerretson vs. Clark, 111 U. S., 120.

Dobson vs. Hartford Carpet Co., 114 U. S., 444 and 445.

Blake vs. Robertson, 94 U. S., 728.

Black vs. Thorne, 111 U. S., 122.

These instructions were almost in the very language of the Supreme Court as contained in the decisions last above cited, and they are in accordance with the rules of law on the question of damages as we have always understood them to be.

Our exceptions are specific. The entire charge of the Court is shown on pages 111 118 of the Record. To the general fairness of the charge we pay our tribute of respect. But notwithstanding this we believe that injustice has been done to our client in the particular matters covered by our exceptions. Whether we are right or wrong is the issue now submitted to this high tribunal for final determination.

Respectfully submitted,

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